

REMARKS

In the Office Action mailed 6/1/2004, Claims 1-20 were rejected as being anticipated by the prior art under 35 U.S.C. §102(b).

In response, Applicant has amended claims 1, 2, 4-5, 9 - 12, and 15 - 19 view of the prior art, as discussed below. In view of these amendments, Applicant respectfully asserts that the claims are now in condition for allowance.

Patentability of Independent Claims 1, 12 and 15

These claims stand rejected under 35 U.S.C. §102(b) as being anticipated by Botsch, U.S. Patent No. 5,409,228. Applicant respectfully traverses the rejection of these now-amended claims for the reasons set forth below after a discussion of the teachings of this reference.

Botsch, U.S. Patent No. 5,409,228

Botsch is an "Alignment System Device for Existing Putters." It is a "visual alignment device . . . that may be readily attached as a temporary training device or bonded as an integral part of [putters]." It further discloses that it is a "hollow hemisphere of the same diameter as a golf ball containing a sighting slot." [*abstract*] Furthermore, it teaches that the "housing" has a "cylindrical lower half", and a "hemispherical upper surface on said cylindrical lower half." [*Claim 1*]

Independent Claim 1 (as amended)

Applicant's Claim 1 (as amended) recites:

"A golf club, comprising:

a head defined by a face and a top surface;

an alignment assembly comprising a dome attached to said top surface, said dome defining a non-hemispherical top member having a non-hemispherical top surface and an underside surface."

Independent Claim 12 (as amended)

Applicant's Claim 12 (as amended) recites:

"An alignment assembly for attachment to a top surface of a golf club head, comprising:

a dome defined by a top surface and a projection surface, said dome further defined by a slot formed in said top surface, said dome defining a non-hemispherical top member having a non-hemispherical top surface and an underside surface, said underside surface in spaced arrangement above said head top surface."

Clearly, the "non-hemispherical top member" of Applicant's amended Claims 1, 12 and 15 are not taught by the "hemispherical upper surface" of the Botsch housing.

Independent Claim 15 (as amended)

Applicant's Claim 15 (as amended) recites:

A golf club having a head defining a face and a top surface, the head comprising:

parallactic alignment means for defining a parallactic alignment sight line said
parallactic alignment means comprising at least one aperture formed in an upper member,
said upper member being coplanar with said top surface and a projection surface
displayed on said head, below said at least one aperture and along said parallactic
alignment sight line, whereby light incident upon said at least one aperture will be
displayed on said projection surface; and

planar alignment means for defining a planar alignment sight line.

Since the *Bosch* device has a hemispherical top surface, it is not physically possible for that
surface to be coplanar with anything except for itself, unlike the device of Claim 15,
wherein the "upper member" is coplanar with "said top surface" of "said head."

Patentability of Independent Claims 1, 12 and 15 (as amended)

By combining the elements of various well-known decisions, one can see that a prima
facie case of anticipation is established only when the Examiner provides:

1. a single reference¹
2. that teaches or enables²

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

3. each of the claimed elements (arranged as in the claim)³
4. expressly or inherently⁴
5. as interpreted by one of ordinary skill in the art.⁵

If the Examiner fails to produce a prima facie case of unpatentability, "then without more the applicant is entitled to the grant of the patent."⁶

Here, as pointed out above, the Botsch reference fails to disclose each of the elements of each of these independent claims, either expressly or inherently. As such, a prima facie case of unpatentability has not been made, and this ground for rejection must be withdrawn.

Dependent Claims

While several of the dependent claims incorporate additional limitations not found in Botsch, it is sufficient to state that these dependent claims, by definition, incorporate additional limitations over the independent claims upon which they depend. As such, they are not anticipated by Botsch either.

Comment on Obviousness

In advance of the Examiner potentially imposing an obviousness rejection under 35 U.S.C. 103, Applicant respectfully indicates that there is ample material within Botsch to sustain a conclusion that Botsch actually teaches away from Applicant's invention, namely,

³ *Lindemann Maschinfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ at 485.

⁴ *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d at 1749-50.

⁵ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

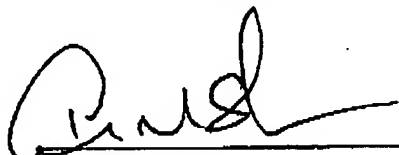
that the shape must be hemispherical on its top surface. In fact, the Botsch disclosure makes ample reference to the benefits of making the alignment device appear to be very similar in size, shape and appearance to a golf ball. It is Applicant's respectful opinion that such a shape is unworkable due to its complexity and consequent cost and aesthetic faults.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

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⁶ *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).